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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,491	05/22/2001	Jeffrey J. Dobbek	SJO919960022US2	9764

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EXAMINER

LAO, SUE X

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 02/11/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Dr

Office Action Summary

Applicati n N .

09/862,491

Applicant(s)

DOBBEK, JEFFREY J.

Examiner

S. Lao

Art Unit

2126

-- The MAILING DATE f this communicati n appears on the c ver sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 42-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. Claims 42-53 are pending. This action is in response to the preliminary amendment mailed 5/22/2001. Applicant has canceled claims 1-41 and added claims 42-53.

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 42-53 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-4, 7-13 of U.S. Patent No. 6,308,325 to Dobbek. Although the conflicting claims are not identical, they are not patentably distinct from each other. In the following discussion, passages in the brackets refer to those of U.S. Patent No. 6,308,325.

As to claim 42, U.S. Patent No. 6,308,325 teaches an electronic device having a device type that is one of a plurality of device types (claim 1, lines 1-3), the device comprising:

(a) non-volatile memory means for storing operational data utilized during operation of the electronic device (claim 2, lines 1-3);

(b) receiver means for receiving a data object externally from the electronic device, the data object including data associated with a plurality of device types (claim 1, lines 5-7);

(c) installation means for installing in the memory means only data from the data object that is associated with the device type of the electronic device (claim 1, lines 14-17) and retrieving from the data object an installation routine, wherein the installation routine is provided with pointers to utilities resident on the electronic device for executing the installation routine (claim 1, lines 19-26); and

(d) download processing means having a download processing routing, the download processing routine executing the installation routine to store into the non-volatile memory means of the electronic device only the data associated with the indicated device types (claim 1, lines 27-29).

As to claims 43, 47, 50, U.S. Patent No. 6,308,325 teaches the data in the data object is selected from the group consisting of program code, device parameters, and combinations thereof (claim 3, claim 4).

As to claim 44, U.S. Patent No. 6,308,325 teaches the plurality of device types represent different electronic products having different functionality but which share an identical hardware platform (claim 12, lines 1-7).

As to claim 45, U.S. Patent No. 6,308,325 teaches the electronic device is a disk drive including the data buffer for temporarily storing the data object, wherein the installation means comprises a controller (claim 8, lines 1-5).

As to claim 46, note discussion of claims 42 and 45 and U.S. Patent No. 6,308,325 further teaches download entity, the download entity including data in a device type table associated with a device type for each of a plurality of types of disk drives (claim 1, lines 5-7); determining a type for the disk drive (claim 7, lines 1-4), executing the installation routine by the electronic device to build a data image in the data image block of the download entity from the data in the device type table that is associated with the determined type for the disk drive (claim 1, lines 11-13); resetting the data buffer to clear the data buffer (claim 1, line 30).

As to claim 48, U.S. Patent No. 6,308,325 teaches second controller, coupled to the first controller, the second controller having a random access memory for storing servo parameters from the download entity that characterize the disk drive (claim 10, lines 1-6).

As to claim 49, note discussion of claim 46, and U.S. Patent No. 6,308,325 further teaches an array of direct access storage devices, each of which having a device type and a non-volatile memory for storing operational data utilized in the operation thereof (claim 12, lines 1-7); an array controller controlling the array of direct access storage devices, the array controller providing a generic download entity to a data buffer of a plurality of the direct-access storage devices to update the memories thereof, the generic download entity including in a device type table operational data associated with a device type for each of a plurality of device types (claim 1, lines 5-7); each direct access storage device having a device controller (claim 8, lines 1-5).

As to claim 51, U.S. Patent No. 6,308,325 teaches download entity includes an installation routine, wherein each of the plurality of direct access storage devices executes the installation routine to store in the non-volatile memory only the operational data in the data buffer that is associated with its respective device type (claim 1, lines 19-29).

As to claim 52, note discussion of claim 42, and U.S. Patent No. 6,308,325 further a block of data, the data block having portions in a device type table associated with each of the plurality of device types (claim 1, lines 1-7); and the download processing routine executing the installation routine to build a data image from data in the device type table that is associated with a determined type for the electronic device (claim 1, lines 8-13, 23-29).

As to claim 53, placing the download entity into a storage device would have been obvious for the purpose of distribution.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 42, 43, 45, 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 42 recites the limitation "a download processing routing" in line 12, which is confusing. For the purpose of art rejection, it is interpreted as "a download processing routine", as best understood and as it appears to be.

Claim 42 recites "the indicated device types" in lines 14-15. There is insufficient antecedent basis for this limitation in the claim.

Claims 43, 47 and 50 recite "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "a group", as best understood and as it appears to be.

Claim 45 recites "the data buffer" in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "a data buffer", as best understood and as it appears to be.

Claim 48 recites "the first controller" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 49 recites "the data image block" in line 20. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "a data image block", as best understood and as it appears to be.


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (703) 305-9657. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (703) 305 9678. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Art Unit: 2126

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Sue Lao



February 9, 2004